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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,517	03/04/2002	Bradley Steven Resch	8866	6459

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EXAMINER	
WANG, SHENGJUN	

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/090,517	RESCH ET AL.	
	Examiner	Art Unit	
	Shengjun Wang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) *13 and 25* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12,14-24, 26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt of applicants' amendments and remarks submitted June 18, 2004 is acknowledged.

Claim Rejections 35 U.S.C.§ 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6 ,9-11, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Yanagida et al. (US 6,024,941).

3. Yanagida et al. teaches stable cosmetic compositions wherein vitamin A is stable. The compositions further comprise phenol compounds, such as BHT, BHA, or hydroxyl substituted benzophenone; EDTA, and other well-known cosmetic ingredients, such as vitamin E, glycerine, polyethylene glycol, polypropylene glycol, fatty acid, and perfume. See, e.g., table 1, 6-2; examples 2-5, 3-7, 4-4, 4-7, 5-4, and the claims.

Claim Rejections 35 U.S.C. 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-12, 14-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagida et al. (US 6,024,941), in view of Oblong et al. (US 5,939,082) and Bissett et al. (US 5,821,237).

5. Yanagida et al. teaches stable cosmetic compositions wherein vitamin A is stabilized by one stabilizer wherein the stabilizer is selected from a groups of compounds including phenols, vitamin E, C, salicylic acid. The compositions may further comprise EDTA, and other well-known cosmetic ingredients, such as vitamin E, glycerine, polyethylene glycol, polypropylene glycol, fatty acid, and perfume. See, particularly, the abstract, table 1, 6-2; examples 2-5, 3-7, 4-4, 4-7, 5-4, and the claims.

6. Yanagida et al. do not teach expressly to exclude parahydroxybenzoic acid ester, or formaldehyde and formaldehyde donating compounds, or employ particular vitamin A derivatives herein, such as retinyl propionate, or employ particular preservative, such as O-phenylphenol.

7. However, as shows in the claims and the examples, Yanagida et al. do not require the present of parahydroxybenzoic acid ester, or formaldehyde, or its donating compounds. Oblong teaches that synthetic or natural vitamin analog, such as retinol esters, e.g., retinyl propionate, are well known in the art for use as vitamin A in cosmetic compositions. See, particularly, column 22, lines 26-52. Bissett et al. teaches that the preservatives herein employed, such as O-phenylphenol, dehydroacetic acid, are well-known preservatives for cosmetic compositions,

particularly, those comprise vitamin A. Bisset further teaches that substantially free of formaldehyde or formaldehyde donating compound is essential for the stability of cosmetic composition. See, particularly, column 15, line 1 to column 16, lines 16.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a vitamin A containing cosmetic composition without using parahydroxybenzoic acid ester and formaldehyde donating compounds, and employ O-phenylphenol as a preservative and retinyl propionate as vitamin A compound.

A person of ordinary skill in the art would have been motivated to make a vitamin A containing cosmetic composition without using parahydroxybenzoic acid ester and formaldehyde donating compounds, and employ O-phenylphenol as a preservative and retinyl propionate as vitamin A compound because parahydroxybenzoic acid ester is not required in the vitamin a containing cosmetic composition, and formaldehyde is known to destabilize cosmetic composition. Further, use a preservative in a cosmetic composition, particularly well-known preservative, is obvious because of its known utility. The employment of a particular retinoid, e.g., retinyl propionate, is seen to be a selection from amongst equally suitable material and as such obvious. Ex parte Winters 11 USPQ 2nd 1387 (at 1388).

Response to the Arguments

Applicants' remarks submitted June 18, 2004 have been fully considered. The arguments with respect to the rejections over Deckers et al. are persuasive. However, the arguments about the rejections over Yanagida et al, and Yanagida et al. in view of Oblong et al. and Bisset et al. are not persuasive for reasons discussed below.

Applicants traverse the anticipation rejections over Yanagida et al., asserting that BHA and BHT employed by Yanagida et al. are antioxidants, but are not preservatives as herein required. Applicants' assertion is in error. The specification does not provide a particular definition for "preservatives" See pages 7-10 in the specification. Referring to phenol preservative, the specification states "phenols are synthetic or natural aromatic compounds that carry at least one –OH group on an aromatic ring. Additional ring substitutions are common." (page 7, lines 20-21). Therefore, "preservative" should be given a broad interpretation acceptable in the art. BHT and BHA meet the structural limitation herein. Further, an antioxidant would be considered as preservative since it would preserve a composition from oxidation.

Applicants contend that the claimed invention is not obvious over Yanagida et al. in view of Oblong et al. and Bisset et al. because "none of the cited references recognize or suggest the potential problem of retinoid degradation over time if used in composition containing parahydroxybenzoic acid esters. Additionally, Bisset et al. teaches away from applicants' invention by stating that propylparaben and methylparaben are preferred preservatives." The examiner disagrees. The instant claims are directed to a composition cosmetic comprising any of the well-known preservatives, but parahydroxybenzoic acid. The discovery of a particular function, i.e., those preservative would not degrade vitamin A would not impart patentable to otherwise obvious utility or composition. It is well settled patent law that mode of action elucidation does not impart patentable moment to otherwise old and obvious subject matter. See In re Swinehart, (169 USPQ 226 at 229). Further, question under 35 U.S.C. 103 is not merely what reference expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made; all disclosures of prior art, including unpreferred

embodiments, must considered. In re Lamberti and Konort (CCPA), 192 USPQ 278. In instant situation, even Bisset disclosed that propylparaben, methylparaben are among the most preferred preservatives, it is noted that o-phenylphenol is also one of most preferred preservative. Therefore, employ of o-phenylphenol would have been obvious to one of ordinary skill in the art, particularly, considering the cited prior art as a whole.

Applicants further cite In re Zurko, asserting "a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified." Zurko is misused by applicant. The claimed invention is obvious not after "source of problem was identified" but before applicants' claimed invention was made. Particularly, prior art does not particularly require parahydroxyl benzoic acid as the preservatives, and the particular preservatives are well-known in the art. The employment of preservatives other than parahydroxyl benzoic acid would have been obvious as discussed above.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHENGJUN WANG
PRIMARY EXAMINER

Shengjun Wang
Primary Examiner
Art Unit 1617